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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,094	03/23/2006	Simon Reginald Hall	9276/HO-P03188US0	6440
29053	7590	10/28/2008	EXAMINER	
FULBRIGHT & JAWORSKI L.L.P			SAYALA, CHHAYA D	
2200 ROSS AVENUE			ART UNIT	PAPER NUMBER
SUITE 2800			1794	
DALLAS, TX 75201-2784				
MAIL DATE		DELIVERY MODE		
10/28/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/540,094	HALL, SIMON REGINALD	
	<b>Examiner</b>	<b>Art Unit</b>	
	C. SAYALA	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13-15 and 111 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11, 13-15 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>3/27/2006</u>	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: ____ .

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-11, 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Foreman et al. (US Pub. 2001/0048955).

Foreman et al. teach separate compartments for two different food items for a pet. For claims 1-5, 7-8 and 11-12, see paragraphs [0008], [0016], [0028], [0032-0037] and [0042], particularly [0037]. Claims 13-15 recite feeding the composition of claim 1 to a cat, which is shown by the patent at paragraphs [0050]-[0051]. See paragraph [0034] which shows ½ slice of bread which meets instant claim 6. Since the patent meets instant claim 1, then by feeding an animal the same composition, it would be inherent that maintaining its weight, providing a macronutrient diet and promoting its health have been achieved by the patent concomitantly. Note the use terminology in claims 8-10 recitation which adds no patentable weight to an already known

composition. See *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau* 57 USPQ 324.

2. Claims 1-11, 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/97630.

The examples show diets with varying amounts of protein, fat and carbohydrate, that can be packaged in “multi-packs” which can be individually packed, see page 6, lines 20+. See page 5, line 14 that discloses that the food can include a cereal bar meeting instant claim 6. See pages 8-9 for instant claims 3-5 and 7-12 content, such disclosure showing different compositions with varying levels of protein and fat contents. Note the use terminology in claims 8-10 recitation which adds no patentable weight to an already known composition. See *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau* 57 USPQ 324. Since the patent meets instant claim 1, then by feeding an animal the same composition, it would be inherent that maintaining its weight, providing a macronutrient diet and promoting its health have been achieved by the patent concomitantly.

3. Claims 1-11, 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/97605.

See claim 1 taken with claims 4 and 5, the patent discloses two different compositions with two vessels. For claim 11 limitations, see page 6, lines 1-19. See pages 8 of the WO patent. Example 1 teaches the same fat and protein amounts. Page 4, lines 21-22 teaches cereal bars and meets claim 6. Page 4, lines 1-10 teaches

two compositions differing in fat content by 5%. Page 8 teaches diets that differ in protein also. Page 8 discloses different levels of macronutrient protein and fat, and also three different ratios. Note the use terminology in claims 8-10 recitation which adds no patentable weight to an already known composition. See *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau* 57 USPQ 324. Since the patent meets instant claim 1, then by feeding an animal the same composition, it would be inherent that maintaining its weight, providing a macronutrient diet and promoting its health have been achieved by the patent concomitantly.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-11, 13-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 10/742360. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application is drawn to an

animal, the co-pending case claims "a feline animal", which is rendered obvious by the claiming of an animal.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala, whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/C. SAYALA/  
Primary Examiner, Art Unit 1794**